

REMARKS

The Office Action of September 10, 2003 is acknowledged. Claims 1, 10, 11, 21-23 and 26-29 stand rejected. Claims 12, 24, 25, and 30 have been objected to, and claims 2-8 and 13-15 are allowed. As a preliminary matter, Applicant notes that this is the fifth Office Action for this Application, including the Final Office Action of June 4, 2002 that was withdrawn. Applicant also notes that the references cited in each of these Office Actions have been of record since the first Office Action. Therefore, the Examiner appears to be in contravention of M.P.E.P. § 707.07(g), which specifies that piecemeal examination should be avoided and that the Examiner should ordinarily reject each claim on all valid grounds available.

Applicant thanks the Examiner for participating in the Telephone Interview conducted on Friday, November 21, 2003. Although no consensus was reached during the telephone conference, the Applicant has considered the Examiner's remarks during the interview in making the above amendments.

Claim Rejections 35 U.S.C. § 102

Claims 1, 27, and 28 were rejected under 35 U.S.C. § 102(e) as being anticipated by the Omni Mount System website pages dated 12/15/99. Claims 1, 27, and 28 were also rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,927,668 to *Cyrell*, which assigned to Omni Mount Systems, Inc. As the website pages and the patent to *Cyrell* disclose the same framing support system, these rejections will be addressed together. Regarding claim 1, the Examiner asserts that the Omni Mount System discloses that the slot has a width being wider than the swivel part where the swivel part is fitted into the slot and narrower than the swivel part where the swivel part engages the catch part. The Examiner also states that the top of the slot is narrower than the middle part of the slot and that the top part of the slot holds the swivel part when the swivel part engages the catch part.

Applicant respectfully disagrees with the Examiner's characterization of the Omni Mount System and traverses the rejection to claim 1. First Applicant notes that the patent to *Cyrell* only includes one exploded view of mounting system 138 in Figure 14 and a cursory description of the parts in the mounting system in column 9, lines 32-37. Page 2

of the website pages to Omni Mount offers a more detailed description of Omni Mount's mounting system; however, there is nothing in either the patent or the website pages that support the assertion that the Omni Mount System has a slot with a width being wider than the swivel part where the swivel part is fitted into the slot. Rather, the patent to *Cyrell* and website pages disclose that the Omni Mount System catch part is a clam shell-type clamp having a clamp plate and jaw held together by a tension screw (page 2 on the Omni Mount website pages 12/15/99). Before the jaw and clamp plate are assembled, there is no slot but rather two separate catch part components. Once the catch part is assembled with the polymer ball swivel part, neither *Cyrell* nor the website pages offer any disclosure or suggestion that the slot between the jaw and the clamp plate is wider than the swivel part such that the swivel part may fit through the slot. Therefore, the Omni Mount System website pages and patent to *Cyrell* do not anticipate claim 1 as previously presented. Nevertheless, in order to expedite the prosecution of this Application, Applicant has amended claim 1 based upon the telephone interview with the Examiner to further clarify the distinction between Applicant's invention and the Omni Mount System.

Claim 27 was also rejected as being anticipated by the Omni Mount System website pages and patent to *Cyrell*, although no explanation was offered how these references anticipate the features of the claim. Applicant traverses this rejection and notes that among other things, claim 27 as previously submitted required a "support assembly whereby a singular movement of the tilting mechanism both tilts and holds the appliance relative to a vertical plane." The Omni Mount System clearly does not anticipate this feature. On page 2 of the Omni Mount System website pages, it is specified under the description of the clamp plate that when the tension screw is tightened, the clamp plate and jaw compress around the ball, locking it in the chosen angle. Therefore, to tilt the Omni Mount System, the tensioning screw must be loosened, the frame moved, and then the tensioning screw retightened in the opposite direction. This is certainly not a singular movement as three separate movements are required. On the other hand, with Applicant's invention, this feature is achieved by the singular motion of rotating the adjustment bolt 76 to both tilt and hold the appliance relative to a vertical plane (paragraph 0030).

In the telephone interview, the Examiner asserted that in making the rejection to claim 27, he did not consider anything after the term "whereby" because the language after

this was functional and need not be considered. The Examiner also asserted that this position was supported by *In re Mason*, 114 USPQ 127 (CCPA 1957). Applicant reminds the Examiner that there is no prohibition on the use of "whereby" clauses in the MPEP, which merely provides in one section that the "whereby" clause may raise a question as to the limiting effect of the language in the claim MPEP § 2106. Furthermore, MPEP § 2173.05(g) specifies that, "[t]here is nothing inherently wrong with defining some part of an invention in functional terms....A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." It has also been found that claims containing "whereby" clauses can serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. MPEP § 2173.05(g) and *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). However, in order to expedite the prosecution of the Application, Applicant has included an amendment to claim 27 eliminating the "whereby" term and recharacterizing the movement of the tilting mechanism using different terms.

Regarding claim 28, as independent claim 27 from which claim 28 depends is not anticipated as discussed above, claim 28 is likewise not anticipated and is allowable.

Claim Rejections U.S.C. § 103

Claims 10-11, 22-23, 26 and 29 were rejected under 35 U.S.C. § 103(a) as being obvious over *Cyrell* or the Omni Mount System's website pages regarding claims 10, 21, 27, and 28. The Examiner asserted "it would have been an obvious matter of design choice to make the swivel part to be barrel in shape, since Applicant has not disclosed that the barrel-shape solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the swivel part formed to shapes other than the barrel-shape." Applicant notes that this rejection was addressed in the previous Response dated June 4, 2003, which the Examiner has not rebutted and which Applicant reasserts and incorporates herein as if fully rewritten. Additionally, Applicant notes that the barrel-shape of the Applicant's swivel part, which is configured to be received in an arcuate slot provides tilting movement in the direction desired yet provides more stability against sideways twisting or tilting than a spherical swivel part. Furthermore, as the Omni

Mount System uses a spherical swivel part, a polymer ball is required that has a high tensile strength and unique compression-set and which is specified as the "heart" of the system (Omni Mount System website pages 12/15/99, page 2)(emphasis in original). The configuration of Applicant's invention does not require that the barrel-shaped swivel part be made of a unique material. Applicant has, however, amended claims 10 and 27 to include features, which with the barrel-shape swivel part interacts with to emphasize the advantages of the barrel-shape member of the invention.

Regarding claim 11, as independent claim 10 from which claim 11 depends is not obvious as discussed above, claim 11 is also not obvious and should be allowable.

Applicant also traverses the rejection to claim 21, which should be allowable for the reasons set forth above regarding claim 10.

Regarding claims 22-23 and 26, as independent claim 21 from which claims 22-23 and 26 depend should be allowable as discussed above, these dependent claims should also be allowable.

Regarding claim 29, as independent claim 27 from which claim 29 depends should be allowable as discussed above, dependent claim 29 should also be allowable.

An earnest attempt has been made to respond fully and completely to the Office Action of September 10, 2003. It is believed that all remaining claims 1-8, 10-15 and 21-31 are in condition for allowance. Accordingly, passage to issuance is respectfully solicited. The Examiner is invited to contact the undersigned with any questions or comments. If necessary to affect a timely response, please consider this response as a petition for extension of time sufficient to make the response timely and charge any fees to Baker & Daniels Deposit Account 02-0387 (75225.77).

Appl. No. 09/754,716
Amdt. Dated December 3, 2003
Reply to Office Action of September 10, 2003

Respectfully submitted,



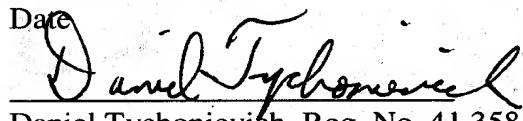
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